

REMARKS

Claims 18 to 37 are pending in the present application. Claims 36 and 37 have been amended. In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Claims 36 and 37 were objected to under 37 C.F.R. § 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. While Applicants do not necessarily agree with the merits of this objection, claims 36 and 37 have been amended to eliminate the basis of the Examiner's objection, and the amendments are believed to be self-explanatory. Entry of the amendments to claims 36 and 37 is requested since the amendments were made directly in response to the Examiner's objection, and the amendments do not raise any new issues. Withdrawal of the objection is therefore respectfully requested.

Claims 18-26, 28-32 and 34 to 37 were rejected under 35 U.S.C. § 103(a) as anticipated by U.S. Patent Publication No. 2002/0194170 ("Israni"). Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine the reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). The prior art must suggest combining the features in the manner contemplated by the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296; In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). "Obviousness is a legal conclusion based on underlying facts of four general types, all of which must be considered . . . : (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art;

and (4) any objective indicia of nonobviousness.” ATD Corp. v. Lydall, Inc., 159 F.3d 534, 546 (Fed. Cir. 1998).

Claim 18 recites a method of transmitting digitally coded traffic information, in which method the digitally coded traffic information is transmitted according to predetermined regulations between a transmitter and at least one receiver via at least one of a unidirectional information channel and a bidirectional information channel. Claim 18 further recites that a subset of possible options of the predetermined regulations is defined, the options relating to at least one of a TMC message format and the ALERT-C Syntax, and that digitally coded traffic information does not make use of all the options, and is always at least one of coded, transmitted, and decoded according to the subset. In the detailed discussion of the rejection, the Examiner concedes that Israni does not disclose or suggest digitally coded traffic information utilizing a subset of possible options of a TMC message format or the ALERT-C Syntax, and that Israni fails to disclose or suggest coding, transmitting and decoding the digitally coded traffic information according to the subset. However, the Examiner contends that it would have been obvious to code, transmit, and decode traffic information without the options of the TMC message format because “[i]t is settled that it would have been obvious to a person of ordinary skill in the art at the time of the invention to omit an element if its function is not desired.” (Office Action, p. 3, citing *In re Wilson*, 153 U.S.P.Q. 740 (C.C.P.A. 1967). Applicants respectfully submit that there is no general proposition of law (settled or otherwise) that stipulates that “it would have been obvious to a person of ordinary skill in the art at the time of the invention to omit an element if its function is not desired,” as explained in greater detail below.

First, the Examiner’s assertion that there is a general proposition of law that “it would have been obvious to a person of ordinary skill in the art at the time of the invention to omit an element if its function is not desired” is simply incorrect: “Obviousness is a legal conclusion based on underlying facts of four general types, all of which must be considered . . . : (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) any objective indicia of nonobviousness.” ATD Corp. v. Lydall, Inc., 159 F.3d 534, 546 (Fed. Cir. 1998). Since obviousness analysis involves factual inquiry specific to each claimed invention, there cannot be any general proposition of obviousness “to omit an element if its function is not desired.” In fact, *In re Wilson* cited by the Examiner is entirely consistent with the

Applicants' assertion that the obviousness conclusion is based on underlying factual inquiry specific to the claimed invention, and *In re Wilson* clearly does not stand for the proposition asserted by the Examiner, i.e., the general proposition that it is obvious in all instances to omit an element if its function is not desired. *In re Wilson* merely indicates that in view of the specific facts on record before the Court, it was obvious to one of ordinary skill in the *chemical arts* to omit "water" when its function "as a foaming agent" was not desired. In particular, the Court of *In re Wilson* stated that:

With respect to claims 16 and 21, appellants contend that it was not obvious at the time of their invention to omit the use of water in the condensation reaction between the polycarbonate and diisocyanate. They point out that the water reacts with the diisocyanate to form urea groups which contribute to the stiffness of the final product whereas in the absence of water, the two reactants produce only urethane linkages which are more stable and less stiff. We note, however, that Newton employs water only as a foaming-inducing agent and that his disclosure shows that relatively small amounts of water are used. *We therefore agree with the factually-based conclusion of the board and the examiner that it was obvious to one of ordinary skill in this art to omit water from the Newton reaction when its function as a foaming agent was not desired.*

In re Wilson, 153 USPQ 740, 742 (CCPA 1967). (Emphasis added). Hence, the ruling of *In re Wilson* only involved an assessment by the Court as to whether one skilled in the art of chemistry would know to omit water in view of a particular use of water in a certain chemical reaction. Accordingly, the Examiner's citation of *In re Wilson* in support of the obviousness conclusion in the present case, which involves data communications technology that is clearly unrelated to chemical arts discussed in *In re Wilson*, is clearly incorrect.

Independent of the above, Applicants note that the Examiner's assertion of obviousness (citing *In re Wilson*) does not address the required motivation to modify the real-time traffic broadcasts of Israni to arrive at the Applicants' invention recited in claim 18. In particular, the Examiner's assertion of obviousness does not address any motivation or suggestion as to why one of ordinary skill in the art would be motivated to expend additional time and effort in terms of program design, system development and testing to deviate from the RDS-TMC standard, when in doing so one might risk introducing into the design, for example, certain unforeseen consequences and/or future compatibility issues. Indeed, such

issues are not at all considered or discussed by Israni since only standardized message formats are to be used.

In view of the foregoing, it is respectfully submitted that claim 18 is not rendered obvious by Israni. Claims 19 to 24, 36 and 37 depend, either directly or indirectly, from claim 18, and are therefore similarly allowable for at least the same reasons as claim 18. Claims 25 and 31 recite features essentially analogous to claim 18, and are therefore allowable for at least the same reasons as claim 18. Claims 26 and 28 to 30 depend from claim 25, and are therefore allowable for at least the same reasons as claim 25. Claims 32, 34 and 35 depend from claim 31, and are therefore allowable for at least the same reasons as claim 31. Withdrawal of the obviousness rejection based on Israni is respectfully requested.

Claims 27 and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Israni in view of U.S. Patent No. 6,070,123 ("Beyer"). Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

It is respectfully submitted that even if it were proper to modify the Israni reference as suggested (which is not conceded), Beyer does not cure the critical deficiencies of Israni (as explained above) with respect to claims 25 and 31, from which claims 27 and 33, respectively, depend, for at least the reasons that Beyer, like Israni, fails to disclose or suggest the features of claims 25 and 31 with respect to coding digitally coded traffic information according to a subset of possible options of predetermined regulations. Indeed, the Office Action recites Beyer only to assert disclosure of a bidirectional link. It is therefore respectfully submitted that claims 27 and 33 are allowable over the combination of Israni and Beyer.

In view of the foregoing, withdrawal of the rejections based on Israni and Beyer is therefore respectfully requested.

Conclusion

In view of the foregoing, it is respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

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